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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,049	12/15/2003	Nathalie Mougin	05725.1259-00	2509

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EXAMINER

MERCIER, MELISSA S

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/735,049	Applicant(s) MOUGIN ET AL.	
	Examiner Melissa S. Mercier	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-89 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-88, drawn to a nail varnish composition, classified in class 424, subclass 061.
- II. Claim 89, drawn to a process of applying nail polish, classified in class 514, subclass 772.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the nail varnish composition can be used as paint for any surface such as tables and walls. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

If applicants elect Group I, this application contains claims directed to the following patentably distinct species:

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Specific film forming gradient copolymer:

- A. the at least one film-forming gradient copolymer comprises at least one hydrophilic monomeric unit
- B. the at least one film-forming gradient copolymer comprises at least one monomeric unit, the homopolymer of which has a Tg of less than or equal to 20°C.
- C. the at least one film-forming gradient copolymer comprises at least one monomeric unit, the homopolymer of which has a Tg of greater than or equal to 20°C.

If applicant elects Group A, the following election is required:

Hydrophilic monomeric unit chosen from units of:

- a. amino(C1-C, alkyl) (meth)acrylate derivatives;
- b. N,N-di(C1-C, alkyl)amino(C1-C6 alkyl)(meth)acrylamides;
- c. di(C1-C8 alkyl)allylamines;
- d. vinylamine;
- e. vinylpyridines;
- f. ethylenic carboxylic acids;
- g. carboxylic anhydrides comprising at least one vinyl bond;
- h. ethylenic sulphonic acids and the salts thereof;
- i. the potassium salt of 3-(acryloyloxy)propanesulphonic acid and the compound of formula $\text{CH}_2=\text{CHCOOCH}_2\text{OCH}_2(\text{OH})\text{CH}_2\text{SO}_3\text{Na}$
- j. amides of unsaturated carboxylic acids;
- k. hydroxyalkyl (meth)acrylates;

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l. (meth)acrylates of polyethylene glycol (5 to 100 EO) and of glycol which are optionally substituted on their end functional group by at least one group chosen from alkyl, phosphate, phosphonate and sulphonate groups;

m. alkoxyalkyl (meth)acrylates;

n. polysaccharide (meth)acrylates;

o. vinylamides;

p. vinyl ethers;

q. methacrylamidopropoxytrimethylammonium betaine;

r. N,N-dimethyl-N-methacryloyloxyethyl-N-(3-sulphopropyl)ammonium betaine;

s. 3-methacryloylethoxycarbonylpyridinium;

t. the compound of formula: in claim 34

u. 4-vinylpyridiniumsulphopropyl betaine

v. N,N-dimethylaminoethyl methacrylate (MADAME)

w. acrylic acid

x. methacrylic acid

y. crotonic acid

z. styrenesulphonic acid

aa. acrylamidopropanesulphonic acid

bb. dimethylaminopropylmethacrylamide (DMPMA)

cc. Styrenesulphonate

dd. hydroxyethyl acrylate

ee. glyceryl acrylate

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ff. ethoxyethyl methacrylate

gg. ethoxyethyl acrylate

hh. methoxypolyethylene glycol (8 or 12 EO) (meth)acrylate

ii. hydroxypolyethylene glycol (meth)acrylate

jj. N-vinylpyrrolidone

kk. N-vinylcaprolactam

ll. acrylamide

mm. N,N-dimethylacrylamide

If applicant elects Group B, the following additional election is required:

The at least one monomeric unit, the homopolymer of which has a Tg of less than or equal to 20°C:

a. ethylenic hydrocarbons comprising from 2 to 10 carbons;

b. acrylates of formula $\text{CH}_2=\text{CHCOOR}_1$, wherein R_1 is chosen from saturated and unsaturated, linear and branched, hydrocarbonaceous groups comprising from 1 to 12 carbons with the exception of the tert-butyl group, wherein at least one heteroatom chosen from O, N, S and Si is optionally inserted, it being possible in addition for the hydrocarbonaceous groups to be optionally substituted with at least one substituent chosen from hydroxyl groups and from halogen atoms chosen from Cl, Br, I and F atoms; or alternatively R_1 is an $-(\text{R}'')_x-(\text{OC}_2\text{H}_4)_n-\text{OR}''$ group, wherein $x = 0$ or 1 , R'' is chosen from saturated and unsaturated, linear and branched, hydrocarbonaceous

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groups comprising from 1 to 12 carbons, n is a number ranging from 5 to 100 and R" is chosen from H and CH₃;

- c. methacrylates of formula: CH₂=C(CH₃)-COOR₂, wherein R₂ is chosen from saturated and unsaturated, linear and branched, hydrocarbonaceous groups comprising from 3 to 12 carbon atoms wherein at least one heteroatom chosen from O, N, S and Si is optionally inserted, it being possible in addition for the hydrocarbonaceous groups to be optionally substituted with at least one substituent chosen from hydroxyl groups and halogen atoms chosen from Cl, Br, I and F atoms; or alternatively R₂ is an -(R'')^x-(OC₂H₅)_n-OR'' group, wherein x = 0 or 1, R'' is chosen from saturated and unsaturated, linear and branched, hydrocarbonaceous groups comprising 1 to 12 carbons, n is a number ranging from 5 to 100 and R''' is chosen from H and OH₃;- N- or N,N-substituted derivatives of unsaturated C₁-12 carboxylic acid amides;
- d. vinyl esters of formula: R₃-CO-O-CH=CH₂, wherein R₃ is chosen from linear and branched alkyl groups comprising from 2 to 12 carbons; and
- e. vinyl alkyl ethers, wherein the alkyl group comprises from 1 to 12 carbons,
- f. isoprene and butadiene;
- g. methyl acrylate, ethyl acrylate, isobutyl acrylate, n-butyl acrylate, ethylhexyl acrylate, methoxyethyl acrylate, ethoxyethyl acrylate and hydroxypolyethylene glycol acrylate;
- h. ethoxyethyl methacrylate, hexyl methacrylate, ethylhexyl methacrylate and hydroxypolyethylene glycol methacrylate;
- i. N-(C₆-12 alkyl)(meth)acrylamides;

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j. vinyl esters of formula: $R_3\text{-CO-O-CH=CH}_2$, where R_3 is chosen from linear and branched alkyl groups comprising from 6 to 12 carbons.

If Applicant elects Group C, the following additional election is required:

The at least one monomeric unit, the homopolymer of which has a Tg of greater than or equal to 20°C:

- a. vinyl compounds of formula: $\text{CH}_2=\text{CH-R}_4$, wherein R_4 is chosen from a hydroxyl group;
- b. an -NH-C(O)-CH_3 group;
- c. an -OC(O)-CH_3 group;
- d. C3 to C8 cycloalkyl groups;
- e. C6 to C20 aryl groups;
- f. C7 to C30 aralkyl groups (C1 to C4 alkyl group);
- g. a 4- to 12-membered heterocyclic group comprising at least one heteroatom chosen from O, N and S;
- h. a heterocyclalkyl (C1 to C4 alkyl) group
- i. acrylates of formula $\text{CH}_2=\text{CH-COOR}_5$, wherein R_5 is chosen from a tert-butyl group;
- j. a C3 to C8 cycloalkyl group;
- k. a C6 to C20 aryl group;
- l. a C7 to C30 aralkyl group (C1 to C4 alkyl group);
- m. a 4- to 12-membered heterocyclic group comprising at least one heteroatom chosen from O, N and S;

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- n. a heterocyclalkyl (C1 to C4 alkyl) group;
- o. methacrylates of formula $\text{CH}_2=\text{C}(\text{CH}_3)\text{-COOR}_6$, wherein R6 is chosen from linear and branched C1 to C4 alkyl groups
- p. a C3 to C8 cycloalkyl group;
- q. a C6 to C20 aryl group;
- r. a C7 to C30 aralkyl group (C1 to C4 alkyl group);
- s. a 4- to 12-membered heterocyclic group comprising at least one heteroatom chosen from O, N and S;
- t. a heterocyclalkyl (C1 to C4 alkyl) group;
- u. alkyl groups wherein at least one heteroatom chosen from O, N, S and P is optionally inserted;
- v. (meth)acrylamides of formula: $\text{CH}_2=\text{C}(\text{R}')\text{-CO-NR}_7\text{R}_8$, wherein R7 and R8, which may be identical or different, are each chosen from a hydrogen atom and linear and branched alkyl groups comprising from 1 to 12 carbon atoms, and R' is chosen from a hydrogen atom and a methyl group.
- w. furfuryl acrylate, isobornyl acrylate, tert-butyl acrylate, tert-butylcyclohexyl acrylate and tert-butylbenzyl acrylate;
- x. methyl methacrylate, n-butyl methacrylate, ethyl methacrylate or isobutyl methacrylate;
- y. styrene or styrenesulphonate;
- z. vinyl acetate and vinylcyclohexane.

The species are independent or distinct because the different combinations would result in materially different compositions with materially different properties.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-20 and 80-88 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

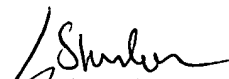
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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